

Remarks

Reexamination and reconsideration of this application, as amended, is requested. Claims 1, 2 and 4 – 25 remain in the application and no new claims have been added or canceled.

Applicant believes there is no charge for this response because no new claims have been added.

Response to the 35 U.S.C. § 103(a) Rejection

The Office Action rejects claims 1, 4, 6, 11 - 13, 16 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Nogaoka (U.S. Patent, No. 6,791,773) in view of Lehtinen et al (U.S. Patent No. 6,518,). Applicant respectfully submits that rejection has been overcome in view of the remarks that follow.

Applicants respectfully submit that the Examiner cannot satisfy the basic requirements of a prima facie case of obviousness by using Nogaoka and Lehtinen to reject the pending independent claims 1, 12 and 21 (Caravella et al U.S. Patent No. 6,041,221 being combined with respect to claim 21). For the Examiner to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the references when combined must teach or suggest all of the claimed limitations. Manual of Patent Examining Procedure, Section 2143. For the reasons articulated below, the Applicants believe that in the present case, the Examiner has not met this burden.

Applicant begins with claim 1. Claim 1 specifically recites:

" A portable communication device comprising:

a display; and

a detachable joystick; wherein the portable communication device is adapted to receive the detachable joystick, and the detachable joystick provides a user input indicated with the display, and wherein the detachable joystick is capable of being stored within the portable communication device when not in use.

Applicant submits that Nagaoka cannot be properly combined with Lehtinen to teach the present invention. Taking for granted that the operating stick of Nagaoka is equivalent to the joy stick of the present invention (please note Applicant does not make this concession but merely accepts this for arguendo), Lehtinen discloses a stylus capable of being disposed within the mobile communication device (please see item 16 of FIG. 4 and text describing such at column 4 line 3.

Applicant submits that there is a significant difference between a stylus and joystick both from a use standpoint as well as a difficulty of storing within the communication device point of view. The common definition of a stylus as used in computer and communication technology is as follows:

"A pointed instrument used as an input device on a pressure-sensitive screen."

The definition of a joystick as used in computer and communication technology is as follows:

"A manual control or cursor device, as one attached to a computer or video game."

Applicant submits it would not be obvious to combine the stylus storable within the communication device of Lehtinen with the non-storable joystick of

Nagaoka for several reasons. First, the operation of the stylus is very distinct from that of the joystick. The stylus during operation may be completely disassociated from the communication device and used with a pressure sensitive screen. Second, it is much easier to store than the present invention because of the elongated and complete removal nature of a stylus. A joystick on the other hand is integrated with components within the device such that movement of the joystick enables control of the device.

Third, by the nature of a stylus, it is used much like a writing instrument and is therefore long and slender, thereby making it easy to store within a case of a communication device. However, a joystick is typically operated by a finger or thumb applying pressure to cause input in the communication device. Again, since it is integrated with components, it cannot simply be completely removed and stored for use.

Therefore, for the foregoing reasons, Applicant submits that it would not be obvious to combine the stylus stored within the communication device of Lehtinen et al. with the non-storable operating stick of Nagaoka to render the present invention as claimed in claim 1.

For at least the reasons set forth above, Applicant submits the rejection of claims 12 and 21 based on 103(a) are improper as well. Regarding claims 2, 4 – 11, 13 – 20 and 22 – 25, as they are dependent from claims 1, 11 and 21, for at least the reasons set forth above, Applicant submits the rejection for these claims have as well been traversed.

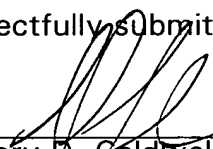
Conclusion

Applicant believes that the foregoing is a full and complete response to the Office Action mailed 24 March 2004, and it is submitted that claims 1, 2 and 4 - 25 are in condition for allowance.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (202) 607-4607 is respectfully solicited.

Respectfully submitted,



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